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**In the United States Patent and Trademark Office**

In re the Application of:

William Kress Bodin	)	
Serial Number: 09/935,393	)	Group: 3629
Docket Number: AUS920010655US1	)	Examiner: Traci L. Smith
Filed on: 08/23/2001	)	
For: "System and Method for Intelligent	)	
Merchandise Indicator and Product	)	
Information Provision"	)	

**APPEAL BRIEF**

***Real Party in Interest per 37 CFR §41.37(c)(1)(i)***

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

***Related Appeals and Interferences per 37 CFR §41.37(c)(1)(ii)***

None.

***Status of Claims per 37 CFR §41.37(c)(1)(iii)***

Claims 1 - 30 are finally rejected. The rejections of Claims 1 - 30 are appealed.

***Status of Amendments after Final Rejections per 37 CFR §41.37(c)(1)(iv)***

No amendments to the claims have been submitted or entered after final rejections.

***Summary of the Claimed Subject Matter per 37 CFR §41.37(c)(1)(v)***

The invention locates a human user in a retail space, such as a showroom or store, then matches the user's preferences or objectives in shopping to items physically nearby the user in the retail space. When a matching item is determined to be physically proximate to the user, the invention draws the user's attention to a physical display, such as a sample on a shelf or table top, by illuminating an LED on the product's display fixture or by turning a spotlight onto the sample. For example, a user Jane has configured her shopping objectives and preferences for purchasing a red pair of shoes in a size 6, preferably from the manufacturer ABC Shoe Co. As she enters a showroom for XYZ Shoe and Accessories Store in a shopping mall, the invention locates her in the showroom, accesses a stock database to search for shoes matching her preferences, finds such a pair, and engages a spotlight which shines on the sample shoes on a display shelf on a nearby wall.

More specifically, claim 1 sets forth a method for achieving these benefits to the user by:

- (a) electronically establishing an identity of a consumer (e.g. using an RFID tag associated with the consumer not the product in para. [0022], a magnetic stripe card in para. [0024], an RF key fob in para. [0024], etc.; and para. [0040]; fig. 5 #52);
- (b) automatically accessing a persistent datastore to retrieve a set of preferences associated with said consumer identity (para. [0026] and [0040]; fig. 5 #53);
- (c) automatically determining if any products on a retail display fixture (fig. match said preferences (paras. [0026], [0041], and [0042]; fig. 5 #54); and
- (d) providing a display unit indicator (para. [0045]; fig. 7 #73) physically near or mounted on said retail display fixture (paras. [0026] and [0042]; fig. 4 #44; fig. 5 #55) for said products which match said preferences such that said consumer is alerted to the presence of the products.

Likewise, independent claim 11 sets forth a computer readable medium encoded with software for providing these benefits to a user, wherein the software performs the steps of:

- (a) electronically establish an identity of a consumer (e.g. using an RFID tag associated with the consumer not the product in para. [0022], a magnetic stripe

- card in para. [0024], an RF key fob in para. [0024], etc.; and para. [0040]; fig. 5 #52);
- (b) automatically access a persistent datastore to retrieve a set of preferences associated with said consumer identity (para. [0026] and [0040]; fig. 5 #53);
  - (c) automatically determine if any products on a retail display fixture match said preferences (paras. [0026], [0041], and [0042]; fig. 5 #54); and
  - (d) provide an activated display unit indicator (para. [0045]; fig. 7 #73) physically near or mounted on said retail display fixture for said products which match said preferences such that said consumer is alerted to the presence of the products (paras. [0026] and [0042]; fig. 4 #44; fig. 5 #55).

And, similarly, independent claim 21 sets forth a system for achieving these functions and benefits, including:

- (a) a consumer identifier unit adapted to establish an identity of a consumer (e.g. using an RFID tag associated with the consumer not the product in para. [0022], a magnetic stripe card in para. [0024], an RF key fob in para. [0024], etc.; and para. [0040]; fig. 5 #52);
- (b) a consumer preference retriever for accessing a persistent datastore to retrieve a set of preferences associated with said consumer identity (para. [0026] and [0040]; fig. 5 #53);
- (c) a preference comparator which receives said set of preferences and compares those to characteristics of products on a retail display fixture to determine if any products match said preferences (paras. [0026], [0041], and [0042]; fig. 5 #54); and
- (d) at least one display unit indicator (para. [0045]; fig. 7 #73) physically near or mounted on said retail display fixture for said retail product display fixture which, responsive to a match being found, is activated such that said consumer is alerted to the presence of the matching product (paras. [0026] and [0042]; fig. 4 #44; fig. 5 #55).

***Grounds for Rejection For Which Review is Sought per 37 CFR §41.37(c)(1)(vi)***

Appellant requests review of the final rejections of claims 1 - 3, 5, 10 - 13, 15, 20 - 23, 25, and 30 under 35 U.S.C. §102(b) over US Patent 5,459,306 to Stein *et al.* (hereinafter “Stein”), and the final rejections of claims 4, 6 - 9, 14, 16 - 19, 24, and 26 - 29 under 35 U.S.C. §103(a) over Stein in view of non-patent publication on the internet by Wayback Machine purportedly captured from www.alerts.com (hereinafter “Alerts.com”).

***Arguments per 37 CFR §41.37(c)(1)(vii)***

Appellant submits that errors in the examination of these claims have occurred, and that the claims should be allowed, because:

- (a) the cited references fail to teach or suggest all of the claimed elements, steps, and limitations; and
- (b) an amendment by the applicant has not been properly considered.

**Rejections of Claims 1 - 3, 5, 10 - 13, 15, 20 - 23, 25, and 30 under 35 U.S.C. §102(b) over Stein**

These claims were rejected in the first Office Action over Stein with the rationale that Stein taught all of the claimed steps, elements, and limitations.

Appellant responded with amendment to the claims which specified that the indicators activated by the invention are indicators which are located physically near a sample of the matching product on display (e.g. a real sample of the product on physical display and not just an image of a product being shown on a computer screen).

Appellant pointed out that by the term “retail display fixture” (see our Figs. 1 and 2), Appellant is referring to variety physical devices which are used to place products on display in an area where a consumer may physically observe the products (our Fig. 3), such as a retail showroom, wholesale warehouse, etc. These types of retail display fixtures include fixtures such as a base display with additional display tiers upon which a plurality of items for sale are displayed (e.g. retail fixtures for clothing, electronics, books, etc.), or a shelf- or wall-based display fixture such as slatwalls and gridwall fixtures, including product risers, and product “faceouts” (our paragraphs [0003] - [0004], figures 1 and 2).

Appellant also pointed out that by the term “display unit indicator mounted on or near a

retail display fixture”, Appellant means a visual or audible indicator for attracting a consumer’s attention, such as a high-intensity LED, alpha-numeric LCD, or computer-driven projectors, mounted on, integrated into, or affixed near the “retail display fixture” (see our paragraphs [0026 - 0028], and figure 7).

Whereas Stein is silent as to providing our display unit indicator on or near a retail display fixture as we have defined and claimed, Appellant requested allowance of Claims 1 - 3, 5, 10 - 13, 15, 20 - 23, 25 and 30, as amended.

In the second Office Action, these rejections over the same art were made final, and the examiner added the rationale that Stein teaches displaying information at a “kiosk” in a store. As the rationale was not further explained, Appellant assumes that the examiner is proposing that Stein’s kiosk includes the display fixtures where products are actually on physical (not just virtual) display, and as such, the propriety of the rejection rests upon whether or not Stein’s kiosk includes such product displays.

Stein describes their kiosk as a computer terminal where products can be “previewed”, and shows a block diagram of a kiosk in their Figure 3. Stein describes their kiosks as being similar to a point-of-sale check out system. While the user may use the computer screen at the kiosk to “preview” products, there is no mention in Stein’s disclosure whether or not real products are on display near or at the kiosk. Further, there is no element in the block diagram (Fig. 3) showing anything besides computer components (e.g. display, keyboard, printer, etc.). Additionally, there is no description of an indicator being activated on or near a physical retail display (e.g. not the same as an indicator shown on a computer screen).

In order to support the rejection, it is incumbent upon the examiner to establish where in Stein’s disclosure these specific steps, elements, and limitations of Appellant’s claims are disclosed, shown, or both. It is not the burden of the Appellant to show that these things are not shown (e.g. proving a negative is not required by the Appellant).

For these reasons, the rationale for the rejections of claims 1 - 3, 5, 10 - 13, 15, 20 - 23, 25 and 30 is erred, and allowance of these claims is requested.

**Rejections of Claims 4, 6 - 9, 14, 16 - 19, 24, and 26 - 29 under 35 U.S.C. §103(a) over Stein in view of Alerts.com**

In the first Office Action, the examiner rejected claims 4, 6 - 9, 14, 16 - 19, 24, and 26 - 29 under 35 U.S.C. §103(a) over Stein in view of Alerts.com. Claims 4 and 6 - 9 depend from Claim 1; claims 14 and 16 - 19 depend from claim 11; and claims 24, and claims 26 - 29 depend from claim 22.

In the rejections, it was reasoned Stein taught the elements, steps, and limitations of claims 1, 11, and 21, as discussed in the foregoing paragraphs, and further reasoned that Alerts.com teaches the additional elements, steps, and limitations of these dependent claims.

Appellant responded by pointing out that Stein in view of Alerts is silent as to providing the claimed display unit indicator on or near a retail display fixture as we defined by Appellant's disclosure, and that there is no suggestion or motivation taught by either Stein or Alerts to modify either reference to include a retail display fixture with a display unit indicator. In fact, Alerts.com teaches notifying a user of potential product interest using an e-mail, not an LED on a product display fixture or a spotlight shone upon a physical product display fixture.

In the second Office Action, these rejections were made final over the same rationale. Therefore, as previously discussed, because Stein fails to teach all of the claimed steps, elements, and limitations, then Stein in view of Alerts.com fails to render these dependent claims obvious. The Examiner has not established or proposed that Alerts.com cures the defects in the rationale for the rejections of the independent claims over Stein alone. For these reasons, the rejection of claims 4, 6 - 9, 14, 16 - 19, 24, and 26 - 29 is improper, and Appellant requests allowance of these claims.

**Failure to Consider Amendment in Examining Claims 1 - 30**

In the second Office Action in which all rejections were made final, on page 4 of the detailed action in the "Response to Arguments", the examiner has stated that "the features upon which the applicant relies (i.e., display unit physically near or mounted on display) are not recited in the previously rejected claims(s)". The amendment to the claims, filed December 19, 2005, specifically added these details to the claims, and thus they must be considered by the examiner. It is inappropriate to continue to reject claims in their originally filed form after they have been amended. The examiner has not held that the amendment was not due entry, nor has

any new matter been added. It simply appears that the examiner has not considered the amendment in the second and final Office Action.

Appellant's representative has verified in the Image File Wrapper for this application that the amendment to the claims on December 19, 2005, included the following change to the fifth step of claim 1, for example:

providing [[an]] a display unit indicator ~~associated with~~ physically near or mounted on said retail display fixture for said products which match said preferences such that said consumer is alerted to the presence of the products.

For these reasons, should the Board of Appeals not determine that an allowance is due for all rejected claims, Appellant requests remand of the application to the examiner with specific instructions to consider the amendment of December 19, 2005.

For these reasons, Appellant requests reversal of the rejections of claims 1 - 30.

Respectfully,



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**Claims Appendix**  
*per 37 CFR §41.37(c)(1)(viii)*  
**Clean Form of Amended Claims**

Claim 1 (previously presented):

A method for indicating that a product or item on display matches a set of consumer preferences comprising the steps of:

electronically establishing an identity of a consumer;

automatically accessing a persistent datastore to retrieve a set of preferences associated with said consumer identity;

automatically determining if any products on a retail display fixture match said preferences; and

providing a display unit indicator physically near or mounted on said retail display fixture for said products which match said preferences such that said consumer is alerted to the presence of the products.

Claim 2 (original):

The method as set forth in Claim 1 wherein said step of establishing the identity of a consumer is selected from the group of reading a radio frequency identifier tag, reading a bar code, reading a magnetic stripe, and receiving input of a personal identifier code.

Claim 3 (original):

The method as set forth in Claim 1 wherein said step of accessing a persistent datastore comprises accessing a database.

Claim 4 (original):

The method as set forth in Claim 1 wherein said step of determining if any products match said preferences includes a step from the group of matching a consumer size, matching a preferred color, and matching a preferred price.



Claim 5 (original):

The method as set forth in Claim 1 wherein said step of providing an indicator associated with products which match said preferences includes a step from the group of illuminating a lamp, illuminating a light emitting diode, and providing a text display.

Claim 6 (original):

The method as set forth in Claim 1 further comprising the steps of:  
retrieving an information data set associated with said products which match said preferences; and  
transmitting said information data set to a preferred electronic destination associated with said consumer such that said consumer may collect said information data set for review and reference.

Claim 7 (original):

The method as set forth in Claim 6 wherein said step of transmitting said information data set comprises transmitting an electronic mail message to an electronic mail address.

Claim 8 (original):

The method as set forth in Claim 6 wherein said step of transmitting said information data set comprises transmitting an electronic file to a electronic mail address.

Claim 9 (original):

The method as set forth in Claim 6 wherein said step of transmitting said information data set comprises transmitting an electronic mail message to a persistent computing device selected from the group of an Internet-enabled wireless telephone, a wireless networked personal digital assistant, and a wireless Internet browser appliance.

Claim 10 (original):

The method as set forth in Claim 1 further comprising the steps of:  
accessing an inventory datastore; and  
determining if a product which matches said preferences is also in stock.

Claim 11 (previously presented):

A computer readable medium encoded with software for indicating that a product or item on display matches a set of consumer preferences, said software causing a computer to perform the steps of:

electronically establish an identity of a consumer;  
automatically access a persistent datastore to retrieve a set of preferences associated with said consumer identity;  
automatically determine if any products on a retail display fixture match said preferences;  
and  
provide an activated display unit indicator physically near or mounted on said retail display fixture for said products which match said preferences such that said consumer is alerted to the presence of the products.

Claim 12 (original):

The computer readable medium as set forth in Claim 11 wherein said software for establishing an identity of a consumer is comprises software for performing a step selected from the group of reading a radio frequency identifier tag, reading a bar code, reading a magnetic stripe, and receiving input of a personal identifier code.

Claim 13 (original):

The computer readable medium as set forth in Claim 11 wherein said software for accessing a persistent datastore comprises software for accessing a database.

Claim 14 (original):

The computer readable medium as set forth in Claim 11 wherein said software for determining if any products match said preferences comprises software for performing a step from the group of matching a consumer size, matching a preferred color, and matching a preferred price.

Claim 15 (original):

The computer readable medium as set forth in Claim 11 wherein said software for providing an indicator associated with products which match said preferences includes a software for performing a step from the group of illuminating a lamp, illuminating a light emitting diode, and providing a text display.

Claim 16 (original):

The computer readable medium as set forth in Claim 11 further comprising software for performing the steps of:

retrieve an information data set associated with said products which match said preferences; and

transmit said information data set to a preferred electronic destination associated with said consumer such that said consumer may collect said information data set for review and reference.

Claim 17 (original):

The computer readable medium as set forth in Claim 16 wherein said software for transmitting said information data set comprises software for transmitting an electronic mail message to an electronic mail address.

Claim 18 (original):

The computer readable medium as set forth in Claim 16 wherein said software for transmitting said information data set comprises software for transmitting an electronic file to an electronic mail address.

Claim 19 (original):

The computer readable medium as set forth in Claim 11 wherein said software for transmitting said information data set comprises software for transmitting an electronic mail message to a persistent computing device selected from the group of an Internet-enabled wireless telephone, a wireless networked personal digital assistant, and a wireless Internet browser appliance.

Claim 20 (original):

The computer readable medium as set forth in Claim 11 further comprising software for performing the steps of:

accessing an inventory datastore; and

determining if a product which matches said preferences is also in stock.

Claim 21 (previously presented):

A system for indicating that a product or item on display matches a set of consumer preferences comprising:

a consumer identifier unit adapted to establish an identity of a consumer;

a consumer preference retriever for accessing a persistent datastore to retrieve a set of preferences associated with said consumer identity;

a preference comparator which receives said set of preferences and compares those to characteristics of products on a retail display fixture to determine if any products match said preferences; and

at least one display unit indicator physically near or mounted on said retail display fixture for said retail product display fixture which, responsive to a match being found, is activated such that said consumer is alerted to the presence of the matching product.

## Claim 22 (original):

The system as set forth in Claim 21 wherein said consumer identifier unit is adapted to perform a function selected from the group of reading a radio frequency identifier tag, reading a bar code, reading a magnetic stripe, and receiving input of a personal identifier code.

## Claim 23 (original):

The system as set forth in Claim 21 wherein said consumer preference retriever is adapted to access a database.

## Claim 24 (original):

The system as set forth in Claim 21 wherein said preference comparitor is adapted to perform a function from the group of matching a consumer size, matching a preferred color, and matching a preferred price.

## Claim 25 (original):

The system as set forth in Claim 21 wherein said indicator comprises an indicator from the group of a lamp, a light emitting diode, and a text display.

## Claim 26 (original):

The system as set forth in Claim 21 further comprising:  
a product information data set retriever for retrieving information associated with said product which matches said preferences; and  
an information data set transmitter adapted to transmit said information data set to a preferred electronic destination associated with said consumer such that said consumer may collect said information data set for review and reference.

## Claim 27 (original):

The system as set forth in Claim 26 wherein said information data set transmitter is adapted to transmit an electronic mail message to an electronic mail address.

## Claim 28 (original):

The system as set forth in Claim 26 wherein said information data set transmitter is adapted to transmit an electronic file to a electronic mail address.

## Claim 29 (original):

The system as set forth in Claim 26 wherein said information data set transmitter is adapted to transmit an electronic mail message to a persistent computing device selected from the group of an Internet-enabled wireless telephone, a wireless networked personal digital assistant, and a wireless Internet browser appliance.

## Claim 30 (original):

The system as set forth in Claim 21 further comprising an inventory datastore query processor for accessing an inventory control system to determine if a product which matches said preferences is also in stock.

**Evidence Appendix**  
*per 37 CFR §41.37(c)(1)(ix)*

No evidence has been submitted by applicant or examiner pursuant to 37 CFR §§1.130, 1.131, or 1.132.

**Related Proceedings Appendix**  
*per 37 CFR §41.37(c)(1)(x)*

No decisions have been rendered by a court or the Board in the related proceedings as identified under 37 CFR §41.37(c)(1)(ii).